

WYTH0144-100 (AM100182 01)  
Serial No. 09/769,107

July 21, 2005 Petition

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of: Vincent P. Sandanayaka et al.

Confirmation No.: 4495

Serial No.: 09/769,107

Art Unit No.: 1625

Filing Date: January 24, 2001

Examiner: Raymond K. Covington

For: METHOD FOR PREPARING ALPHA-SULFONYL HYDROXAMIC ACID DERIVATIVES

Customer No.: 35139

**MAIL STOP AMENDMENT**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

VIA EXPRESS MAIL LABEL NO: EV146 600 975US  
DATE SENT: July 21, 2005

**PETITION**

SIR:

Applicants hereby petition for a refund of the \$1520 fees paid on April 25, 2005 for a three month extension of time (\$1020.00) and for a Notice of Appeal (\$500.00), as well as for an indication that the period in question is not Applicant Delay for Patent Term Adjustment purposes. The extension and the Notice of Appeal were filed solely to keep the case alive while awaiting action by the Office which was delayed for reasons beyond Applicants' control.

**Summary Of Events of The Relevant Time Period**

A Final Office Action was mailed on October 25, 2004, setting a three month shortened statutory period for response. The PAIR system lists this action as non-final, although the actual document clearly indicates it is final. Applicants filed a response on January 7, 2005, within the three month shortened statutory period for response.

A review of the file will show that the October 25, 2004 Action was a remailed version of an action mailed a year earlier, which apparently was lost in the mail. After the January 7, 2005 response was filed, Applicant retained new counsel, who questioned the remailed action to

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verify due dates. On March 28, 2005, Applicants' Attorney, Michael A. Patané, contacted Examiner Covington and Supervisory Docket Clerk, Brenda Gray, to confirm the remailed action reset the period for response. Both the examiner and docket clerk assured Applicants' attorney that the period for response was reset, and that the examiner would take action on the January 7, 2005 response shortly.

PAIR indicates that Applicants' January 7, 2005 response was given to the examiner on March 9, 2005, nearly two months after it was filed, and well into the fifth month of the six month statutory period. There is no indication for the reason for the delay. Since no Notice of Allowance or Advisory Action had been received by Applicants, and the Examiner had indicated that his response was forthcoming, on April 25, 2005, Applicants filed a Request for a three month extension of time and a Notice of Appeal to keep the case pending for the two month period following the Notice.

Still not having heard from the Examiner, on May 10, 2005 Applicants attorney again contacted Examiner Covington. Although PAIR shows the January 7, 2005 response had been forwarded to the examiner two months earlier, Examiner Covington indicated, for the first time, that the response was "not showing in E-dan" and that he could not take action on it. He suggested calling Supervisory Docket Clerk Brenda Gray. Ms. Gray said she would take care of the situation, and that the problem should have been addressed internally weeks earlier. Applicants do not pretend to be familiar with or understand the internal electronic docketing/accessibility of the Office, but from these conversations, it seems that, from March 9, 2005 until the May 10, 2005 conversation, Applicants' January 7, 2005 response was docketed to the Examiner, but somehow was not available to him for review. Regardless, Examiner Covington confirmed, that same day, that the problem had been taken care of and that he would act on the case shortly.

Another month passed by, and in an effort to avoid any further extension fees or the need to file an Appeal Brief, Applicants' attorney left several messages for Examiner Covington, eventually contacting his SPE, Cecelia Tsang, on June 14, 2005 who ultimately directed him to acting SPE, Celia Chang due to Examiner Tsang's upcoming leave. Examiner Chang, on June 16, 2005, indicated that she had spoken with Examiner Covington and he was acting on the case. Applicants' attorney confirmed the same with Examiner Covington and tracked the progress of the case over the next week, until an action was mailed on June 22, 2005 as a non-final action withdrawing the finality of the prior action and presenting a requirement for restriction.

#### **Request for Refund**

Thus, the period of time from filing of Applicants' response in January until it was forwarded to the examiner in March (two months), coupled with the exceptionally long period of time thereafter when the examiner was unable to access the case (two months), and the period thereafter before an action actually issued on June 22, 2005 (over a month), the need for the extension and associated fees, as well as the need for a Notice of Appeal, was necessitated by Office delay. Ultimately, neither was required in light of the withdrawal of finality of the prior action. Accordingly, Applicants respectfully request a refund of \$1520 to cover the extension fees (\$1020) as well as the fee for the Notice of Appeal (\$500).

#### **Request For Treatment During Patent Term Adjustment Calculations**

Perhaps more importantly, Applicants respectfully request that, regardless of whether the fees are refunded or not, the time associated with the extensions and the Notice of Appeal, should not count as Applicant delay for purposes of Patent Term Adjustment. In fact, since the Office's latest action was mailed over four (4) months after Applicants' response, Applicants respectfully assert that the Patent Term Adjustment calculation should reflect a minimum of 46

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days of Office delay reflecting the period between Applicants' January 7, 2005 response and the June 22, 2005 Action less four months. (see 35 U.S.C. § 154 (b)(1)(A)(ii)).

Applicants respectfully request favorable action on this Petition granting **a refund in the amount of \$1520** and an indication in the official file that the period in question **will not be counted as Applicant delay** and **will be counted as Office delay** for Patent Term Adjustment calculations.

Applicants hereby authorize the Commissioner to debit for any fees due from or credit any overpayment or refund to customer account no 50-1275.

Respectfully submitted,

COZEN O'CONNOR



Date: July 21, 2005

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